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OFFICE OF PETITIONS

In re Application of:
Charles Ruelke et al.
Application No. 09/307,443
Filed: May 10, 1999
Attorney Docket No. CM02872J

DECISION ON PETITION

This is a decision on the petition, filed May 24, 2002,¹ which is being treated as a petition under 37 CFR 1.181 to withdraw the holding of abandonment of the above-identified application or, alternatively, under the unintentional provisions of 37 CFR 1.137(b) in view of the statement of unintentional delay appearing in the petition.

The petitions are dismissed.

Any request for reconsideration of the decision under 37 CFR 1.137(b) must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704. *Note also* 37 CFR 1.181(f).

The application was held abandoned for failure to timely reply within the meaning of 37 CFR 1.113 to the final Office action, mailed May 18, 2001, which set a shortened statutory period for reply of three (3) months. A three-month extension of time was obtained under the provisions of 37 CFR 1.136(a). A Notice of Abandonment was mailed on March 27, 2002.

Petitioner asserts that a reply, consisting of a response with a certificate of mailing executed on October 18, 2001, a petition for extension of time with authorization to charge petitioner's Deposit Account and an affidavit, was timely filed and received in the USPTO on February 20,

¹ This petition was only recently brought to the attention of the Office of Petitions. Any inconvenience caused petitioner by the delay in replying to the petition is sincerely regretted.

2002 as evidenced by a copy of the postcard receipt. A copy of the reply was also submitted. Petitioner also requests that the petition fee of \$130 be refunded.

DISCUSSION OF PETITION UNDER 37 CFR 1.181

A review of the file record indicates that the above-identified reply to the final Office action was timely submitted and received in the USPTO but was not matched with the file for consideration by the examiner prior to the mailing of the Notice of Abandonment. A Notice of Appeal was not filed.

STATUTE, REGULATIONS AND PRACTICE¹

37 C.F.R. § 1.113(a) states in part that:

(a) On the second or any subsequent examination or consideration the rejection or other action may be made final, whereupon applicant's or patent owner's response is limited to appeal in the case of rejection of any claim (§ 1.191) or to amendment as specified in § 1.116...

37 C.F.R. §§ 1.116(a) and (b) state that:

(a) After final rejection or action (§ 1.113) amendments may be made cancelling claims or complying with any requirement of form which has been made. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. The admission of, or refusal to admit, any amendment after final rejection, and any proceedings relative thereto, shall not operate to relieve the application or patent under reexamination from its condition as subject to appeal or save the application from abandonment under § 1.135.

(b) If amendments touching the merits of the application or patent under reexamination are presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon showing of good and sufficient reasons why they are necessary and were not earlier presented.

M.P.E.P. § 706.07(f) states in part that:

All final rejections setting a three (3) month shortened statutory period (SSP) for response should contain one of the Form Paragraphs (7.39; 7.40; 7.41) advising applicant that if the response is filed within two (2) months of the date of the final Office action, the shortened statutory period will expire at three (3) months from the date of the final rejection or on the date the advisory action is mailed, whichever is later. Thus, a variable response period will be established. In no event can the statutory period for response expire later than 6 months from the date of the final rejection.

¹ The statute, rules and practice were applicable at the time the final Office action was issued.

...
Advisory Actions

(4) Where the final Office action sets a variable response period as set forth in paragraph 1 above, AND applicant files a complete first response to the final Office action within 2 months of the date of the final Office action, the examiner must determine if the

...
(c) Response does not put the application in condition for allowance - then the advisory action should inform applicant that the SSP for response expires 3 months from the date of the final rejection or as of the mailing date of the advisory action, whichever is later, by checking the appropriate box at the top portion of the Advisory Action form, PTOL - 303.

...
For example, if applicant initially responds within 2 months from the date of mailing of a final rejection and the examiner mails an advisory action before the end of 3 months from the date of mailing of the final rejection, the shortened statutory period will expire at the end of 3 months from the date of mailing of the final rejection. In such a case, any extension fee would then be calculated from the end of the 3 - month period. If the examiner, however, does not mail an advisory action until after the end of 3 months, the shortened statutory period will expire on the date the examiner mails the advisory action and any extension fee may be calculated from that date.

OPINION

The reply to the final Office action on February 20, 2002, and the Certificate of Mailing under 37 C.F.R. § 1.8(a) dated October 18, 2001 establish that a proposed after-final amendment was timely submitted. The issue to be determined is whether the reply constitutes a proper response to the final Office action within the meaning of 37 C.F.R. § 1.113 and thus stopped the statutory period for reply set in the final Office action.

Under current practice, after an Office action is made final, it is incumbent upon an applicant to take appropriate steps to ensure against the abandonment of his/her application. Because the reply to the final Office action submitted is not deemed to place the application in condition for allowance, the reply required may be a Notice of Appeal or the filing of a Request for Continued Examination (RCE) and requisite fees. While it is regrettable that the USPTO did not timely consider the proposed after final amendment and an Advisory Action was not mailed before the expiration of the maximum statutory period, there is no provision in the statute or rule that permits stopping or resetting a statutory period in an Advisory Action.

In view of the absence of a timely filing of (1) an amendment that places the application in condition for allowance, (2) a Notice of Appeal, or (3) a request for continued examination

(RCE) under 37 CFR 1.114, the application became abandoned by operation of law. The petition to withdraw the holding of abandonment cannot be granted.

DISCUSSION OF PETITION UNDER 37 CFR 1.137(b)

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. *See* MPEP 711.03(c)(II).

OPINION

The instant petition lacks items (1) and (2).

With regard to item (1), as noted above, this application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of May 18, 2001. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2)), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination (RCE) and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). *See* MPEP 711.03(c)(II)(A)(2). Since the amendment submitted does not *prima facie* place the application in condition for allowance, the reply required must be a Notice of Appeal (and appeal fee), an RCE, or the filing of a continuing application under 37 CFR 1.53(b).

As to item (2), the statute requires at 35 U.S.C. 41(a)(7) payment of a petition fee. The petition was not accompanied by the \$1,500 petition fee required by statute.

CONCLUSION

The petition under 37 CFR 1.181 to withdraw the holding of abandonment is dismissed.

The petition to revive under 37 CFR 1.137(b) is dismissed as the required reply to continue prosecution and payment of the \$1,500 petition fee have not been submitted.

A petition under 37 CFR 1.181 does not require a fee. Therefore, the request to refund the \$130 fee for filing the petition is granted.

A courtesy copy of the Advisory Action accompanies this decision on petition.


Further correspondence with respect to this matter should be addressed as follows:

By Mail: Mail Stop PETITION
 Commissioner for Patents
 P. O. Box 1450
 Alexandria, VA 22313-1450

By hand: U. S. Patent and Trademark Office
 Customer Service Window, Mail Stop Petitions
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

The centralized facsimile number is (571) 273-8300.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3218.


Frances Hicks
Petitions Examiner
Office of Petitions

Enclosure: Copy of the Advisory Action in response to the Amendment After Final Action

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/307,443

Applicant(s)

RUELKE, CHARLES R.

Examiner

Benny Lee

Art Unit

2817

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 May 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See *Continuation Sheet*. (See 37 CFR 1.116 and 41.33(a)).

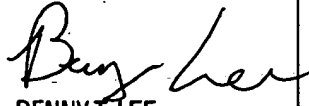
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): The prior art rejection regarding cls 30, 31.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 1.
Claim(s) objected to: _____
Claim(s) rejected: 2,3; 4-11; 12-24; 25-29; 30,31.
Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____


BENNY T. LEE
PRIMARY EXAMINER
ART UNIT 2817

Continuation of 3. NOTE: For example, the amendments to cl 25 broadens the scope of the claim thus raising new issues. The added limitations to cl 12 regarding isolating outside interference raises new matter issues.